

**REMARKS**

In the Final Office Action mailed on April 30, 2004, the Examiner: (1) objected to claims 32 and 57 for asserted minor informalities; (2) rejected claims 1-8, 10, 17, 20, 23-27, 29, 31-41, 43, 48, 51, and 53-58 under U.S.C. § 102(e) as being anticipated by Hillebrand et al. (U.S. Patent No. 6,571,003); (3) rejected claims 1-7, 10, 14-16, 24-27, 31-40, 43, 46, 47, and 54-58 under 35 U.S.C. § 102(e) as being anticipated by Hayes, Jr. et al. (U.S. Patent No. 6,283,858); (4) rejected claims 33 and 58 under 35 U.S.C. § 102(b) as being anticipated by Apple Corps; (5) rejected claims 1-32 and 34-57 under 35 U.S.C. § 103(a) as being unpatentable over Massengill (U.S. Publication No. 2002/0064302); and (6) rejected claims 8, 9, 11-13, 17-23, 28-30, 41, 42, 44, 45, and 48-53 under 35 U.S.C. § 103(a) as being unpatentable over Hayes, Jr. et al.

By this amendment, Applicants amend claims 32 and 57 to correct the asserted minor informalities noted in the Office Action. Applicants respectfully request the Examiner to withdraw the objection to claims 32 and 57. For the reasons explained below, all of the claim rejections should be withdrawn and pending claims 1-58 should be allowed.

**1. Rejection of claims 1-8, 10, 17, 20, 23-27, 29, 31-41, 43, 48, 51, and 53-58 under U.S.C. § 102(e) as being anticipated by Hillebrand et al.**

Claim 1 is patentable over Hillebrand et al. because that reference does not teach enabling an individual to construct a simulated facial image using a facial construction computer program, where the facial construction computer program permits the individual to select at least one of a head, eyes, nose, lips, ears, and eyebrows.

Hillebrand et al. is directed to a skin imaging analysis system in which the need for a consumer or a beauty consultant to identify defects in the consumer's skin is eliminated by having a computer identify the skin defects. (col. 1, ll. 17-41). Noting that beauty consultations at retail cosmetic counters are very subjective, Hillebrand et al. aims to reduce the involvement of the consumer and the beauty counselor working with a skin imaging analysis system. (col. 1, ll. 17-41). Hillebrand et al. proposes a system in which a computer (controller 200, for example) analyzes skin defects without the subjective input of the consumer and the beauty counselor.

Hillebrand et al. does not teach enabling an individual to construct a simulated facial image using a facial construction computer program, where the facial construction computer program permits the individual to select at least one of a head, eyes, nose, lips, ears, and eyebrows. As discussed in col. 5, ll. 4-14 of Hillebrand et al., a picture of a person's face is taken using a camera, and the picture is then digitized to generate a digital image. Hillebrand et al. further teaches the determination of sub-images (e.g., the area covered by reference numeral 704 in Figure 11), and as part of that process discusses that eyes and noses may even be excluded from consideration while analyzing a portion of the acquired digital image. (col. 6, ll. 12-24).

In contrast, claim 1 recites, among other things, enabling an individual to construct a simulated facial image using a facial construction computer program, where the facial construction computer program permits the individual to select at least one of a head, eyes, nose, lips, ears, and eyebrows. Because Hillebrand et al. does not teach all of the subject matter of claim 1, Applicants respectfully request that the Examiner withdraw the rejection of claim 1 under 35 U.S.C. § 102(e) based on Hillebrand et al.

Claims 2-8, 10, 17, 20, 23-27, 29, and 31-33 depend, directly or indirectly, from claim 1 and thus are patentable for at least the reasons given above with respect to claim 1.

Claim 34 is patentable over Hillebrand et al. for reasons similar to those discussed above with respect to claim 1. In particular, that reference does not teach constructing a simulated facial image using a facial construction computer program, where the facial construction computer program permits the individual to select at least one of a head, eyes, nose, lips, ears, and eyebrows, as recited in claim 34.

Claims 35-41, 43, 48, 51, and 53-58 depend, directly or indirectly, from claim 34 and thus are patentable for at least the reasons given above with respect to claim 34.

**2. Rejection of claims 1-7, 10, 14-16, 24-27, 31-40, 43, 46, 47, and 54-58 under U.S.C. § 102(e) as being anticipated by Hayes, Jr. et al.**

Claim 1 is patentable over Hayes, Jr. et al. because that reference does not teach enabling an individual to construct a simulated facial image using a facial construction computer program, where the facial construction computer program permits the individual to select at least one of a head, eyes, nose, lips, ears, and eyebrows.

Hayes, Jr. et al. is directed to methods for customizing video games. (col. 4, ll. 17-18). As part of this process, as discussed in col. 4, ll. 17-65 of Hayes, Jr. et al., first various images related to a video game character are input to a digital computer, then an image of a video game player is input into the digital computer, and finally, the facial features of the video game character are replaced with the facial features of the video

game player. Thus, the player can use his image in the game, as opposed to the video game character's facial image.

In contrast, claim 1 recites, among other things, enabling an individual to construct a simulated facial image using a facial construction computer program, where the facial construction computer program permits the individual to select at least one of a head, eyes, nose, lips, ears, and eyebrows. Because Hayes, Jr. et al. does not teach all of the subject matter of claim 1, Applicants respectfully request that the Examiner withdraw the rejection of claim 1 under 35 U.S.C. § 102(e) based on Hayes, Jr. et al.

Further, claim 1 is patentable because Hayes, Jr. et al. does not teach enabling the individual to simulate use of the selected cosmetic product on the simulated facial image and to view on the display device an alteration of the simulated facial image having the simulated cosmetic product, as required by claim 1.

Claims 2-7, 10, 14-16, 24-27, and 31-33 depend, directly or indirectly, from claim 1 and thus are patentable for at least the reasons given above with respect to claim 1.

Claim 34 is patentable over Hayes, Jr. et al. for reasons similar to those discussed above with respect to claim 1. To be more specific, Hayes, Jr. et al. does not teach constructing a simulated facial image using a facial construction computer program, where the facial construction computer program permits the individual to select at least one of a head, eyes, nose, lips, ears, and eyebrows. Moreover, Hayes, Jr. et al. does not teach causing a simulation of use of the selected cosmetic product on the simulated facial image, as further recited in claim 34.

Claims 35-40, 43, 46, 47, and 54-58 depend, directly or indirectly, from claim 34 and thus are patentable for at least the reasons given above with respect to claim 34.

**3. Rejection of claims 33 and 58 under 35 U.S.C. § 102(b) as being anticipated by Apple Corps**

Claim 33 is patentable over Apple Corps because that reference does not teach a system that comprises a processor configured to perform a method comprising, among other things, enabling an individual to select a cosmetic product and enabling the individual to simulate use of the selected cosmetic product on a simulated facial image. Contrary to the Examiner's apparent assertions, claim 33 does not merely recite a system comprising a processor. Rather, claim 33 recites a system that comprises a processor "configured to perform the method of claim 1." (emphasis supplied). No such configuration is disclosed in Apple Corps. Even if Apple Corps could be considered as disclosing a processor "capable of performing the method," as alleged in the Office Action, there is nothing in that reference that teaches the specific processor configuration of claim 1.

Claim 58 depends from claim 34, and includes recitations similar to those of claim 33. Accordingly claim 58 should be allowable over Apple Corps for at least similar reasons.

**4. Rejection of claims 1-32 and 34-57 under 35 U.S.C. § 103(a) as being unpatentable over Massengill**

With respect to the rejection of claims 1-32 and 34-57 under 35 U.S.C. § 103(a) as being unpatentable over Massengill, Applicants respectfully request that the rejection be withdrawn because the Office Action does not set forth a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be satisfied. First, there must be some suggestion or motivation, either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine references. M.P.E.P. ' 2143. Second, there must be a reasonable expectation of success. Id. Third, the prior art reference (or references when combined) must teach or suggest all of the claim elements. Id. Moreover, the requisite teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. M.P.E.P. ' 706.02(j) (citing In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991)).

Applicants respectfully submit that there is no *prima facie* case of obviousness because one of ordinary skill in the art would not have had any motivation or suggestion to modify Massengill in the manner suggested by the Examiner. Massengill is not even from the same field of art as that of the claims. Massengill relates to an educational tool for a patient seeking plastic surgery. (paragraphs 4 and 26). Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness.

Further, Massengill does not teach or suggest enabling an individual to construct a simulated facial image using a facial construction computer program, where the facial construction computer program permits the individual to select at least one of a head, eyes, nose, lips, ears, and eyebrows, as recited by claim 1. Contrary to the Examiner's unsupported allegation, "the use of a simulated image" is not an obvious design choice.

Massengill teaches that a patient's scanned photographs are properly sized and then a patient can perform "autosurgery" on himself by answering questions, such as "Is your nose too Small?" or "Do you wish a nose without an uptilt at the tip?" (paragraphs 28-30). Massengill further teaches that depending on the responses from the patient, a

central computer programmed with computer software transmits an image of the desired nose to the patient's computer. (paragraph 30).

In contrast, claim 1 recites, among other things, enabling an individual to construct a simulated facial image using a facial construction computer program, where the facial construction computer program permits the individual to select at least one of a head, eyes, nose, lips, ears, and eyebrows. Because Massengill does not teach or suggest all of the subject matter of claim 1, Applicants respectfully request that the Examiner withdraw the rejection of claim 1 under 35 U.S.C. § 103(a) based on Massengill.

Further, Massengill does not teach or suggest enabling the individual to simulate use of the selected cosmetic product on the simulated facial image and to view on the display device an alteration of the simulated facial image having the simulated cosmetic product, as required by claim 1. Contrary to the Examiner's unsupported allegation about how "the cosmetic product can be viewed to be the cosmetic surgical procedure," simulating use of a cosmetic product on a simulated facial image is not the same as a virtual cosmetic surgical procedure. Using cosmetic products and performing cosmetic surgical procedures are clearly different from one another. Thus, for this additional reason, Applicants submit that Massengill does not teach or suggest all of the subject matter of claim 1, and Applicants respectfully request that the Examiner withdraw the rejection of claim 1 under 35 U.S.C. § 103(a) based on Massengill.

Claims 2-32 depend, directly or indirectly, from claim 1 and thus are patentable for at least the reasons given above with respect to claim 1.

Claim 34 is patentable over Massengill for reasons at least similar to those discussed above in connection with regard to claim 1.

Claims 35-57 depend, directly or indirectly, from claim 34 and thus are patentable for at least the same reasons as claim 34.

**5. Rejection of claims 8, 9, 11-13, 17-23, 28-30, 41, 42, 44, 45, and 48-53 under 35 U.S.C. § 103(a) as being unpatentable over Hayes, Jr. et al.**

With respect to the rejection of claims 8, 9, 11-13, 17-23, 28-30, 41, 42, 44, 45, and 48-53 under 35 U.S.C. § 103(a) as being unpatentable over Hayes, Jr. et al., Applicants respectfully request that the rejection be withdrawn because the Office Action does not set forth a *prima facie* case of obviousness. Applicants respectfully submit that there is no *prima facie* case of obviousness because one of ordinary skill in the art would not have had any motivation or suggestion to modify Hayes, Jr. et al. in the manner suggested by the Examiner. Hayes, Jr. et al. is not even from the same field of art as the claims. Hayes, Jr. et al. relates to customizing video games. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness.

Further, Hayes, Jr. et al. does not teach or suggest, for at least the reasons given above with respect to claim 1, enabling an individual to construct a simulated facial image using a facial construction computer program, where the facial construction computer program permits the individual to select at least one of a head, eyes, nose, lips, ears, and eyebrows, as required by claims 8, 9, 11-13, 17-23, 28-30.

Moreover, Hayes, Jr. et al. does not teach or suggest, for at least the reasons given above with respect to claim 1, enabling the individual to simulate use of the selected cosmetic product on the simulated facial image and to view on the display



device an alteration of the simulated facial image having the simulated cosmetic product, as required by claims 8, 9, 11-13, 17-23, 28-30.

Similarly, with respect to claims 41, 42, 44, 45, and 48-53, for at least the reasons given above with respect to claim 34, Hayes, Jr. et al. does not teach or suggest constructing a simulated facial image using a facial construction computer program, where the facial construction computer program permits the individual to select at least one of a head, eyes, nose, lips, ears, and eyebrows.

Moreover, Hayes, Jr. et al. does not teach or suggest, for at least the reasons given above with respect to claim 34, causing a simulation of use of the selected cosmetic product on the simulated facial image, as required by claims 41, 42, 44, 45, and 48-53.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-58 in condition for allowance. Applicants submit that the proposed amendments of claims 32 and 57 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since the Examiner suggested the amendments in the Final Office Action. Therefore, this Amendment should allow for immediate action by the Examiner.

Finally, Applicants submit that the entry of the Amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

The Final Office Action contains a number of statements reflecting characterizations of the claims and/or the related art. Regardless of whether any such

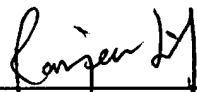
statements are addressed above, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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